

PATENT
Docket: 16356.726 (DC-01900)
Customer No. 000027683

REMARKS

Claims 1-11 are rejected under 35 U.S.C. §102(b) as being anticipated by *Haigler* (U.S. 4,887,298). Claims 1-11 are rejected under 35 U.S.C. §102(b) as being anticipated by *Cullison et al.* (U.S. 4,296,278).

Applicants traverse these rejections on the grounds that these references are defective in supporting a rejection under 35 U.S.C. §102(b).

Claim 1 includes: "A speaker system, comprising:

at least one transducer;

at least one speaker analog circuit; and

a diagnostics circuit coupled to the at least one transducer and the at least one speaker analog circuit, and generating at least one test signal routed to the speaker analog circuit, the transducer and to an analog activity sensor, the test signal being sampled by the analog activity sensor before and after transmission to the speaker analog circuit."

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Haigler* and *Cullison* patents must contain all of the claimed elements of claim 1. However, the claimed diagnostics circuit coupled to the transducer and the speaker analog circuit and generating at least one test signal routed to the speaker analog circuit, the transducer and to an analog activity sensor, the test signal being sampled by the analog activity sensor before and after transmission to the speaker analog circuit, are neither shown nor taught in the *Haigler* or *Cullison* patents. Therefore, the rejection is unsupported by the art and should be withdrawn.

PATENTDocket: 16356.726 (DC-01900)
Customer No. 000027683

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant further traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness...

In the present case, the references do not teach the diagnostics circuit coupled to the transducer and the speaker analog circuit and generating at least one test signal routed to the speaker analog circuit, the transducer and to an analog activity sensor, the test signal being sampled by the analog activity sensor before and after transmission to the speaker analog circuit. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 U.S.C. §103 provides that:

A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains...(Emphasis added)

PATENT

Docket: 16356.726 (DC-01900)

Customer No. 000027683

Because all the limitations of claim 1 have not been met by the *Haigler* and *Cullison* patents, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The Federal Circuit has held that a reference did not render claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the Examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

PATENTDocket: 16356.726 (DC-01900)
Customer No. 000027683

Therefore, independent claim 1 and the claims dependent therefrom are submitted to be allowable.

Claims 12-23 are rejected under 35 U.S.C. §103(a) as unpatentable over *Haigler* or *Cullison* in view of *Soutar* (5,644,505).

Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Claim 12 includes: A computer system comprising:

- a processor;
- a memory coupled to the processor;
- a speaker system coupled to the processor, wherein the speaker system includes a diagnostic circuit;
- at least one transducer; and
- at least one speaker analog circuit, wherein the diagnostics circuit is coupled to the at least one transducer and the at least one speaker analog circuit, and generating at least one test signal routed to the speaker analog circuit, the transducer and to an analog activity sensor, the test signal being sampled by the analog activity sensor before and after transmission to the speaker analog circuit.

PATENT
Docket: 16356.726 (DC-01900)
Customer No. 000027683

These claimed features are neither taught nor suggested by the references for the reasons set forth above. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because the combination of these references does not teach or even suggest the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The MPEP § 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in

PATENT
Docket: 16356.726 (DC-01900)
Customer No. 000027683

the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1793, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claim invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1 and 12 and the claims dependent therefrom are submitted to be allowable.

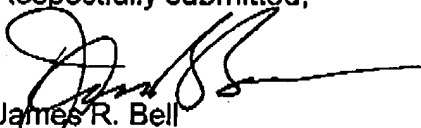
In view of the above, it is respectfully submitted that claims 1-6, 8-10, 12, 14-18 and 20-22 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

PATENT

Docket: 16356.726 (DC-01900)

Customer No. 000027683

Respectfully submitted,



James R. Bell

Registration No. 26,528

Dated: 11-5-03
HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com


154959_1.DOC

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Facsimile No.: 703-872-9314

Date: 11/5/03



Signature of person sending facsimile